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MILLER PATENT SERVICES 2500 DOCKERY LANE RALEIGH, NC 27606			EXAMINER SHELEHEDA, JAMES R	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/753,430

Applicant(s)

KRISHNAN ET AL.

Examiner

James Sheleheda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-17, 19, 22, 23, 25-36, 38, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (Butler) (US 2002/0007493A1) (of record) in view of Zigmond et al. (Zigmond) (6,692,020) (of record).

As to claim 1, Butler discloses a method of presenting entertainment program material (paragraph 13), comprising:

providing a segment of programming (paragraph 32);

providing a plurality of segments of ancillary information relevant to the segment of programming (paragraph 19);

presenting a first presentation of the segment of programming (paragraph 15 and 19) having a first window overlaying the segment of programming (paragraphs 20, 21 and 58), the first window containing a first segment of ancillary information relevant to the segment of programming (paragraphs 21 and 4).

While Butler discloses presenting a second presentation of the segment of programming (recording and replaying a program; paragraph 35) and a window overlaying the segment of programming (paragraph 20, 21 and 58), the window

containing a segment of ancillary information relevant to the segment of programming (paragraphs 21 and 4), he fails to specifically disclose a second segment of ancillary information relevant to the segment of programming, wherein the first and second segments of ancillary information are selected from the plurality of segments of ancillary information in accordance with a selection algorithm, and wherein the selection algorithm is based upon at least one of 1) a count of a number of presentations of the segment of programming and 2) a random selection algorithm.

In an analogous art, Zigmond discloses a broadcast receiving system (Fig. 3; column 7, lines 1-25) which will present a first segment of information with a first content presentation (advertisement inserted into a received program; column 7, lines 26-36) and present a second segment of information with a second presentation of the content (updated advertisement in playback of recorded program; column 14, lines 1-12), using a selection algorithm (column 11, lines 31-49) based upon a count of a number of presentations of the segment of programming (column 14, lines 1-12 and column 13, lines 40-47) for the typical benefit of ensuring that a user is always provided with current advertising that they will be interested in (column 5, lines 1-14 and column 14, lines 1-9).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler's system to include a second segment of ancillary information relevant to the segment of programming, wherein the first and second segments of ancillary information are selected from the plurality of segments of ancillary information in accordance with a selection algorithm, and wherein the selection

algorithm is based a count of a number of presentations of the segment of programming, as taught by Zigmond, for the typical benefit of removing obsolete information and ensuring that a user is always provided with current advertising that they will have an interest in.

As to claim 2, while Butler and Zigmond disclose wherein at least the first presenting comprises transmitting the segment of programming to a receiver (see Butler at paragraph 32) along with the first and second segment of ancillary information (see Butler at paragraph 19), they fail to specifically disclose a set-top box.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention by applicant to utilize a set top box, which is typically much smaller and lower cost than a personal computer, for receiving and processing broadcast signals for the typical benefit of enabling the receipt and display of content signals onto a television display utilizing a common, low cost set top box.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler and Zigmond's system to include a set-top box for the typical benefit of enabling the receipt and display of content signals onto a television display utilizing a common, low cost set top box.

As to claim 3, while Butler and Zigmond disclose at a receiver (see Butler at Fig. 2), selecting the first segment of ancillary information for overlaying in the first presentation (see Zigmond at column 7, lines 26-36) and selecting the second segment

of ancillary information for overlaying the second presentation (see Zigmond at column 14, lines 1-12), they fail to specifically disclose a set-top box.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention by applicant to utilize a set top box, which is typically much smaller and lower cost than a personal computer, for receiving and processing broadcast signals for the typical benefit of enabling the receipt and display of content signals onto a television display utilizing a common, low cost set top box.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler and Zigmond's system to include a set-top box for the typical benefit of enabling the receipt and display of content signals onto a television display utilizing a common, low cost set top box.

As to claim 5, Butler and Zigmond disclose wherein the selecting is carried out by selecting one of the segments of ancillary information in accordance with a number of times the segment of programming has been played at the set-top box (see Zigmond at column 14, lines 1-12 and column 13, lines 40-47).

As to claim 6, while Butler and Zigmond disclose transmitting the segment of programming (see Butler at paragraph 32) along with a plurality of segments of ancillary information to a receiver (paragraph 19); and at the receiver, selecting the first and second segments of ancillary information for overlaying in the first and second window from the plurality of segments of ancillary

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information (see Zigmond at column 7, lines 26-36, column 14, lines 1-12 and column 13, lines 40-47), they fail to specifically disclose a set-top box.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention by applicant to utilize a set top box, which is typically much smaller and lower cost than a personal computer, for receiving and processing broadcast signals for the typical benefit of enabling the receipt and display of content signals onto a television display utilizing a common, low cost set top box.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler and Zigmond's system to include a set-top box for the typical benefit of enabling the receipt and display of content signals onto a television display utilizing a common, low cost set top box.

As to claim 7, Butler and Zigmond disclose counting a number of times the segment of programming is presented to a viewer through the set-top box (counting the number of times the inserted ad, and therefore the program holding it, have been played; see Zigmond at column 13, lines 40-47 and column 14, lines 1-13).

As to claim 8, Butler and Zigmond disclose selecting the first and second segments of ancillary information in accordance with the number of times the segment has been previously presented (wherein an ad is replaced and no longer shown if it has been shown too many times; see Zigmond at column 14, lines 1-12 and column 13, lines 40-47).

As to claim 14, Butler and Zigmond disclose wherein the segment of programming includes a marker indicative of a location for overlaying the window (see Butler at paragraph 52).

As to claim 15, Butler and Zigmond disclose wherein the first window comprises a default window (the initial ad window associated with the media; see Butler at paragraphs 21 and 4) and wherein the second window overlays the first window (wherein the new ad will replace the previous ad in the program; see Zigmond at column 14, lines 1-12).

As to claim 16, Butler and Zigmond disclose at a service provider, selecting the first segment of ancillary information for overlaying in the first presentation (service provider solely deciding how ads are to be inserted; see Zigmond at column 11, lines 50-59) and selecting the second segment of ancillary information for overlaying the second presentation (service provider solely deciding how ads are to be inserted; see Zigmond at column 11, lines 50-59).

As to claim 19, Butler and Zigmond disclose receiving the segment of programming along with a plurality of segments of ancillary information at a service provider (see Butler at paragraph 19); and



at the service provider, selecting the first and second segments of ancillary information for overlaying in the first and second window from the plurality of segments of ancillary information (service provider solely deciding how ads are to be inserted; see Zigmond at column 11, lines 50-59).

As to claim 23, Butler and Zigmond disclose wherein the first window comprises a default window (the initial ad window associated with the media; see Butler at paragraphs 21 and 4) and wherein the second window overlays the first window (wherein the new ad will replace the previous ad in the program; see Zigmond at column 14, lines 1-12).

As to claim 25, Butler discloses a method of presenting entertainment program material (paragraph 13), comprising:

presenting a first presentation of the segment of programming (paragraph 15 and 19) having a static window overlaying the segment of programming (window holding content pre-defined by the provider; paragraphs 20, 21, 48 and 58), the static window containing a static segment of ancillary information relevant to the segment of programming (containing content predefined by the provider to be shown at a set time; paragraphs 4, 21 and 48).

While Butler discloses presenting a second presentation of the segment of programming (recording and replaying a program; paragraph 35) and a window overlaying the segment of programming (paragraph 20, 21 and 58), the window

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containing a segment of ancillary information relevant to the segment of programming (paragraphs 21 and 4), he fails to specifically disclose a variable segment of ancillary information relevant to the segment of programming.

In an analogous art, Zigmond discloses a broadcast receiving system (Fig. 3; column 7, lines 1-25) which will present a first segment of information with a first content presentation (advertisement inserted into a received program; column 7, lines 26-36) and present a second, variable, segment of information with a second presentation of the content (updated advertisement based upon current time of playback of the recorded program; column 14, lines 1-12) for the typical benefit of ensuring that a user is always provided with current advertising that they will be interested in (column 5, lines 1-14 and column 14, lines 1-9).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler's system to include a variable segment of ancillary information relevant to the segment of programming, as taught by Zigmond, for the typical benefit of removing obsolete information and ensuring that a user is always provided with current advertising that they will have an interest in.

As to claim 26, Butler disclose a television receiver (Fig. 2; paragraphs 16-18), comprising:

a receiver (Fig. 2, receiver, 58) for receiving signals representing segments of programming (paragraph 31 and 32) and signals representing a plurality of segments of

ancillary information (paragraphs 19 and 32), and delivering the signals representing segments of programming to a display interface (video subsystem, 66; paragraph 34);  
a central processor (processor, 52);  
program means operating on the programmed processor (controlling the system; paragraph 31) for:

delivering a first presentation of a segment of programming (paragraph 15 and 19) having a first window overlaying the segment of programming to the display interface (paragraphs 20, 21 and 58), the first window containing a first segment of ancillary information relevant to the segment of programming (paragraphs 21 and 4).

While Butler discloses presenting a second presentation of the segment of programming (recording and replaying a program; paragraph 35) and a window overlaying the segment of programming (paragraph 20, 21 and 58), the window containing a segment of ancillary information relevant to the segment of programming (paragraphs 21 and 4), he fails to specifically disclose a second segment of ancillary information relevant to the segment of programming, wherein the first and second segments of ancillary information are selected from the plurality of segments of ancillary information in accordance with a selection algorithm and a set top box.

In an analogous art, Zigmond discloses a broadcast receiving system (Fig. 3; column 7, lines 1-25) which will present a first segment of information with a first content presentation (advertisement inserted into a received program; column 7, lines 26-36) and present a second segment of information with a second presentation of the content (updated advertisement in playback of recorded program; column 14, lines 1-12), using

a selection algorithm (column 11, lines 31-49) based upon a count of a number of presentations of the segment of programming (column 14, lines 1-12 and column 13, lines 40-47) for the typical benefit of ensuring that a user is always provided with current advertising that they will be interested in (column 5, lines 1-14 and column 14, lines 1-9).

Additionally, the examiner takes Official Notice that it was notoriously well known in the art at the time of invention by applicant to utilize a set top box, which is typically much smaller and lower cost than a personal computer, for receiving and processing broadcast signals for the typical benefit of enabling the receipt and display of content signals onto a television display utilizing a common, low cost set top box.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler's system to include a second segment of ancillary information relevant to the segment of programming, wherein the first and second segments of ancillary information are selected from the plurality of segments of ancillary information in accordance with a selection algorithm, and wherein the selection algorithm is based a count of a number of presentations of the segment of programming, as taught by Zigmond, for the typical benefit of removing obsolete information and ensuring that a user is always provided with current advertising that they will have an interest in.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler and Zigmond's system to include a set-

top box for the typical benefit of enabling the receipt and display of content signals onto a television display utilizing a common, low cost set top box.

As to claim 29, Butler and Zigmond disclose counting a number of times the segment of programming is presented to a viewer through the set-top box (counting the number of times the inserted ad, and therefore the program holding it, have been played; see Zigmond at column 13, lines 40-47 and column 14, lines 1-13).

As to claim 30, Butler and Zigmond disclose selecting the first and second segments of ancillary information in accordance with the number of times the segment has been previously presented (wherein an ad is replaced and no longer shown if it has been shown too many times; column 14, lines 1-12 and column 13, lines 40-47).

As to claim 35, Butler and Zigmond disclose wherein the segment of programming includes a marker indicative of a location for overlaying the window (see Butler at paragraph 52).

As to claim 36, Butler and Zigmond disclose wherein the first window comprises a default window (the initial ad window associated with the media; see Butler at paragraphs 21 and 4) and wherein the second window overlays the first window (wherein the new ad will replace the previous ad in the program; see Zigmond at column 14, lines 1-12).

As to claim 38, Butler disclose a television receiver (Fig. 2; paragraphs 16-18), comprising:

a receiver (Fig. 2, receiver, 58) for receiving signals representing segments of programming (paragraph 31 and 32) and signals representing a plurality of segments of ancillary information (paragraphs 19 and 32), and delivering the signals representing segments of programming to a display interface (video subsystem, 66; paragraph 34);

a central processor (processor, 52);

program means operating on the programmed processor (controlling the system; paragraph 31) for:

delivering a first presentation of a segment of programming (paragraph 15 and 19) having a static window overlaying the segment of programming (window holding content pre-defined by the provider; paragraphs 20, 21, 48 and 58), the static window containing a static segment of ancillary information relevant to the segment of programming (containing content predefined by the provider to be shown at a set time; paragraphs 4, 21 and 48).

While Butler discloses presenting a second presentation of the segment of programming (recording and replaying a program; paragraph 35) and a window overlaying the segment of programming (paragraph 20, 21 and 58), the window containing a segment of ancillary information relevant to the segment of programming (paragraphs 21 and 4), he fails to specifically disclose a variable segment of ancillary information relevant to the segment of programming.

In an analogous art, Zigmond discloses a broadcast receiving system (Fig. 3; column 7, lines 1-25) which will present a first segment of information with a first content presentation (advertisement inserted into a received program; column 7, lines 26-36) and present a second, variable, segment of information with a second presentation of the content (updated advertisement based upon current time of playback of the recorded program; column 14, lines 1-12) for the typical benefit of ensuring that a user is always provided with current advertising that they will be interested in (column 5, lines 1-14 and column 14, lines 1-9).

Additionally, the examiner takes Official Notice that it was notoriously well known in the art at the time of invention by applicant to utilize a set top box, which is typically much smaller and lower cost than a personal computer, for receiving and processing broadcast signals for the typical benefit of enabling the receipt and display of content signals onto a television display utilizing a common, low cost set top box.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler's system to include a variable segment of ancillary information relevant to the segment of programming, as taught by Zigmond, for the typical benefit of removing obsolete information and ensuring that a user is always provided with current advertising that they will have an interest in.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler and Zigmond's system to include a set-top box for the typical benefit of enabling the receipt and display of content signals onto a television display utilizing a common, low cost set top box.

As to claim 39, Butler discloses a storage medium storing (Fig. 2) instructions which, when executed on a programmed processor (paragraph 31), carry out a method of presenting entertainment program material (paragraph 13), comprising:

accessing a segment of programming (paragraph 32);

accessing a plurality of segments of ancillary information relevant to the segment of programming (paragraph 19);

presenting a first presentation of the segment of programming (paragraph 15 and 19) having a first window overlaying the segment of programming (paragraphs 20, 21 and 58), the first window containing a first segment of ancillary information relevant to the segment of programming (paragraphs 21 and 4).

While Butler discloses presenting a second presentation of the segment of programming (recording and replaying a program; paragraph 35) and a window overlaying the segment of programming (paragraph 20, 21 and 58), the window containing a segment of ancillary information relevant to the segment of programming (paragraphs 21 and 4), he fails to specifically disclose a second segment of ancillary information relevant to the segment of programming, wherein the first and second segments of ancillary information are selected from the plurality of segments of ancillary information in accordance with a selection algorithm, and wherein the selection algorithm is based upon at least one of 1) a count of a number of presentations of the segment of programming and 2) a random selection algorithm.



In an analogous art, Zigmond discloses a broadcast receiving system (Fig. 3; column 7, lines 1-25) which will present a first segment of information with a first content presentation (advertisement inserted into a received program; column 7, lines 26-36) and present a second segment of information with a second presentation of the content (updated advertisement in playback of recorded program; column 14, lines 1-12), using a selection algorithm (column 11, lines 31-49) based upon a count of a number of presentations of the segment of programming (column 14, lines 1-12 and column 13, lines 40-47) for the typical benefit of ensuring that a user is always provided with current advertising that they will be interested in (column 5, lines 1-14 and column 14, lines 1-9).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler's system to include a second segment of ancillary information relevant to the segment of programming, wherein the first and second segments of ancillary information are selected from the plurality of segments of ancillary information in accordance with a selection algorithm, and wherein the selection algorithm is based a count of a number of presentations of the segment of programming, as taught by Zigmond, for the typical benefit of removing obsolete information and ensuring that a user is always provided with current advertising that they will have an interest in.

As to claim 41, Butler discloses a storage medium storing (Fig. 2) instructions which, when executed on a programmed processor (paragraph 31), carry out a method of presenting entertainment program material (paragraph 13), comprising:

presenting a first presentation of the segment of programming (paragraph 15 and 19) having a static window overlaying the segment of programming (window holding content pre-defined by the provider; paragraphs 20, 21, 48 and 58), the static window containing a static segment of ancillary information relevant to the segment of programming (containing content predefined by the provider to be shown at a set time; paragraphs 4, 21 and 48).

While Butler discloses presenting a second presentation of the segment of programming (recording and replaying a program; paragraph 35) and a second window overlaying the segment of programming (paragraph 20, 21 and 58), the window containing a segment of ancillary information relevant to the segment of programming (paragraphs 21 and 4), he fails to specifically disclose a variable segment of ancillary information relevant to the segment of programming.

In an analogous art, Zigmond discloses a broadcast receiving system (Fig. 3; column 7, lines 1-25) which will present a first segment of information with a first content presentation (advertisement inserted into a received program; column 7, lines 26-36) and present a second, variable, segment of information with a second presentation of the content (updated advertisement based upon current time of playback of the recorded program; column 14, lines 1-12) for the typical benefit of ensuring that a user

is always provided with current advertising that they will be interested in (column 5, lines 1-14 and column 14, lines 1-9).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler's system to include a variable segment of ancillary information relevant to the segment of programming, as taught by Zigmond, for the typical benefit of removing obsolete information and ensuring that a user is always provided with current advertising that they will have an interest in.

As to claims 4, 9, 17, 22, 27, while Butler and Zigmond disclose selecting the first and second segments of ancillary information, they fail to specifically disclose wherein the selection is random.

The examiner takes official notice that it is notoriously well known in the art to make selections between a series of items randomly, such as when a multitude of equally valid items are available, for the typical benefit of easily selecting one of plural ads which are valid for a viewer.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler and Zigmond's system to include wherein the selection is performed randomly for the typical benefit of easily selecting one of plural ads which are valid for a viewer.

As to claim 28, Butler and Zigmond disclose wherein the selecting is carried out by selecting one of the segments of ancillary information in accordance with a number

of times the segment of programming has been played at the set-top box (see Zigmond at column 14, lines 1-12 and column 13, lines 40-47).

As to claims 10, 11, 12, 13, 31, 32, 33 and 34, while Butler and Zigmond disclose first and second windows, they fail to specifically disclose wherein the windows are the same size and shape, of differing sizes and shapes, overlay the same segment of programming or overlay differing segments of programming.

The examiner takes official notice that it is notoriously well known in the art that overlay window can utilize any display characteristic desired, including any particular size, shape, or position on screen, for the typical benefit of allowing the service provider maximum flexibility in how information is presented to a viewer.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler and Zigmond's system to include any of wherein the windows are the same size and shape, of differing sizes and shapes, overlay the same segment of programming or overlay differing segments of programming for the typical benefit of allowing the service provider maximum flexibility in how information is presented to a viewer.

3. Claims 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler and Zigmond as applied to claim 16 above, and further in view of Huizer et al. (Huizer) (5,873,022) (of record).

As to claim 18, while Butler and Moore disclose wherein the selecting is carried out by selecting one of the segments of ancillary information in accordance with a number of times the segment of programming has been previously presented (wherein an ad is replaced and no longer shown if it has been shown too many times; column 14, lines 1-12 and column 13, lines 40-47), they fail to specifically disclose wherein the segment is transmitted by the service provider each time the segment is replayed.

In an analogous art, Huizer discloses a video distribution system (Fig. 1) wherein the service provider (VOD server, 1) acts as a remote video recorder for a user (column 3, lines 47-58) and provides programming to be played back for a user (column 3, lines 31-58). This provides the typical benefit of reducing the cost of complexity of a home user's equipment by providing video storage at a headend facility.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler and Zigmond's system to include wherein the segment is transmitted by the service provider each time the segment is replayed, as taught by Huizer, for the typical benefit of reducing the cost of complexity of a home user's equipment by providing video storage at a headend facility.

As to claim 20, while Butler and Zigmond disclose counting a number of times the segment of programming is presented to a viewer (counting the number of times the inserted ad, and therefore the program holding it, have been played; see Zigmond at column 13, lines 40-47 and column 14, lines 1-13), they fail to specifically disclose

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wherein the segment is transmitted by the service provider each time the segment is presented.

In an analogous art, Huizer discloses a video distribution system (Fig. 1) wherein the service provider (VOD server, 1) acts as a remote video recorder for a user (column 3, lines 47-58) and provides programming to be played back for a user (column 3, lines 31-58). This provides the typical benefit of reducing the cost of complexity of a home user's equipment by providing video storage at a headend facility.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler and Zigmond's system to include wherein the segment is transmitted by the service provider each time the segment is presented, as taught by Huizer, for the typical benefit of reducing the cost of complexity of a home user's equipment by providing video storage at a headend facility.

As to claim 21, Butler, Zigmond and Huizer disclose selecting the first and second segments of ancillary information in accordance with the number of times the segment has been previously transmitted (wherein an ad is replaced and no longer shown if it has been shown too many times; column 14, lines 1-12 and column 13, lines 40-47).

4. Claims 24, 37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler in view of Vogel (5,446,488) (of record).

As to claim 24, Butler discloses a method of presenting entertainment program material (paragraph 13), comprising:

providing a segment of programming (paragraph 32);

providing a plurality of segments of ancillary information relevant to the segment of programming (paragraph 19);

presenting a first presentation of the segment of programming (paragraph 15 and 19) having a first window overlaying the segment of programming (paragraphs 20, 21 and 58), the first window containing a first segment of ancillary information relevant to the segment of programming (paragraphs 21 and 4), wherein the segment of ancillary information is selected from the plurality of segments of ancillary information in accordance with a selection algorithm (selecting a segment based upon timing information; paragraphs 48 and 58).

While Butler discloses presenting a second presentation of the segment of programming (recording and replaying a program; paragraph 35) and an algorithm determining the segment selected to overlay the programming (selecting a segment based upon timing information; paragraphs 48 and 58), he fails to specifically disclose presenting the second presentation having no window overlaying the segment of programming.

In an analogous art, Vogel discloses a television receiving system (Fig. 1; column 1, lines 8-12) wherein programming is received interspersed with non-program material (column 4, lines 13-32 and column 5, lines 30-52) and wherein the program is recorded and played back without the non-program material (column 4, lines 13-32 and column 5,

lines 32-52) based upon user payment for the removal of the non-program content (column 5, line 65-column 6, line 18 and column 6, lines 26-40) for the typical benefit of allowing the removal of unwanted program signals (column 3, lines 49-64) while still providing broadcasters with additional revenue (column 3, lines 64-68) and allowing advertisers to more accurately assess what audience is actually viewing their advertisements (column 3, line 68-column 4, line 10).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler's system to include presenting the second presentation having no window overlaying the segment of programming, as taught by Vogel, for the typical benefit of allowing the removal of unwanted program signals while still providing broadcasters with additional revenue and allowing advertisers to more accurately assess what audience is actually viewing their advertisements.

As to claim 37, Butler disclose a television receiver (Fig. 2; paragraphs 16-18), comprising:

a receiver (Fig. 2, receiver, 58) for receiving signals representing segments of programming (paragraph 31 and 32) and signals representing a plurality of segments of ancillary information (paragraphs 19 and 32), and delivering the signals representing segments of programming to a display interface (video subsystem, 66; paragraph 34);

a central processor (processor, 52);

program means operating on the programmed processor (controlling the system; paragraph 31) for:



delivering a first presentation of a segment of programming (paragraph 15 and 19) having a first window overlaying the segment of programming to the display interface (paragraphs 20, 21 and 58), the first window containing a first segment of ancillary information relevant to the segment of programming (paragraphs 21 and 4), wherein the first segments of ancillary information is selected from the plurality of segments of ancillary information in accordance with a selection algorithm (selecting the segments based upon program timing information; paragraphs 48 and 58).

While Butler discloses presenting a second presentation of the segment of programming (recording and replaying a program; paragraph 35) and an algorithm determining the segment selected to overlay the programming (selecting a segment based upon timing information; paragraphs 48 and 58), he fails to specifically disclose presenting the second presentation having no window overlaying the segment of programming.

In an analogous art, Vogel discloses a television receiving system (Fig. 1; column 1, lines 8-12) wherein programming is received interspersed with non-program material (column 4, lines 13-32 and column 5, lines 30-52) and wherein the program is recorded and played back without the non-program material (column 4, lines 13-32 and column 5, lines 32-52) based upon user payment for the removal of the non-program content (column 5, line 65-column 6, line 18 and column 6, lines 26-40) for the typical benefit of allowing the removal of unwanted program signals (column 3, lines 49-64) while still providing broadcasters with additional revenue (column 3, lines 64-68) and allowing

advertisers to more accurately assess what audience is actually viewing their advertisements (column 3, line 68-column 4, line 10).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler's system to include presenting the second presentation having no window overlaying the segment of programming, as taught by Vogel, for the typical benefit of allowing the removal of unwanted program signals while still providing broadcasters with additional revenue and allowing advertisers to more accurately assess what audience is actually viewing their advertisements.

As to claim 40, Butler discloses a storage medium storing (Fig. 2) instructions which, when executed on a programmed processor (paragraph 31), carry out a method of presenting entertainment program material (paragraph 13), comprising:

- accessing a segment of programming (paragraph 32);
- accessing a plurality of segments of ancillary information relevant to the segment of programming (paragraph 19);
- presenting a first presentation of the segment of programming (paragraph 15 and 19) having a first window overlaying the segment of programming (paragraphs 20, 21 and 58), the first window containing a first segment of ancillary information relevant to the segment of programming (paragraphs 21 and 4), wherein the segment of ancillary information is selected from the plurality of segments of ancillary information in accordance with a selection algorithm (selecting the segments based upon program timing information; paragraphs 48 and 58).

While Butler discloses presenting a second presentation of the segment of programming (recording and replaying a program; paragraph 35) and an algorithm determining the segment selected to overlay the programming (selecting a segment based upon timing information; paragraphs 48 and 58), he fails to specifically disclose presenting the second presentation having no window overlaying the segment of programming.

In an analogous art, Vogel discloses a television receiving system (Fig. 1; column 1, lines 8-12) wherein programming is received interspersed with non-program material (column 4, lines 13-32 and column 5, lines 30-52) and wherein the program is recorded and played back without the non-program material (column 4, lines 13-32 and column 5, lines 32-52) based upon user payment for the removal of the non-program content (column 5, line 65-column 6, line 18 and column 6, lines 26-40) for the typical benefit of allowing the removal of unwanted program signals (column 3, lines 49-64) while still providing broadcasters with additional revenue (column 3, lines 64-68) and allowing advertisers to more accurately assess what audience is actually viewing their advertisements (column 3, line 68-column 4, line 10).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler's system to include presenting the second presentation having no window overlaying the segment of programming, as taught by Vogel, for the typical benefit of allowing the removal of unwanted program signals while still providing broadcasters with additional revenue and allowing advertisers to more accurately assess what audience is actually viewing their advertisements.

5. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Butler in view of Zigmond and Vogel.

As to claim 42, Butler discloses a method of presenting entertainment program material (paragraph 13), comprising:

providing a segment of programming (paragraph 32);

providing a plurality of segments of ancillary information relevant to the segment of programming (paragraph 19);

wherein the ancillary information comprises additional information about the segment of programming (paragraph 4, 19 and 46);

presenting a plurality of presentations of the programming (recording and replaying a program; paragraphs 15, 19 and 35);

wherein during certain presentations of the segment of programming (paragraphs 20, 21 and 58), a window containing a selected segment of ancillary information (paragraphs 20, 21 and 58) selected from the plurality of segments of ancillary information is presented (selecting a segment based upon timing information; paragraphs 48 and 58), wherein the window overlays the segment of programming (paragraphs 20, 21 and 58).

While Butler discloses wherein the selected segments of ancillary information are selected from the plurality of segments of ancillary information in accordance with a selection algorithm (selecting a segment based upon timing information; paragraphs 48 and 58), he fails to specifically disclose wherein the selection algorithm is based upon a

count of a number of presentations of the segment of programming, wherein during certain other of the presentations of the segment of programming, no window overlays the segment of programming and wherein the selection algorithm further selects presentations for which no window overlays the segment of programming.

In an analogous art, Zigmond discloses a broadcast receiving system (Fig. 3; column 7, lines 1-25) which will present a first segment of information with a first content presentation (advertisement inserted into a received program; column 7, lines 26-36) and present a second segment of information with a second presentation of the content (updated advertisement in playback of recorded program; column 14, lines 1-12), using a selection algorithm (column 11, lines 31-49) based upon a count of a number of presentations of the segment of programming (column 14, lines 1-12 and column 13, lines 40-47) for the typical benefit of ensuring that a user is always provided with current advertising that they will be interested in (column 5, lines 1-14 and column 14, lines 1-9).

Additionally, in an analogous art, Vogel discloses a television receiving system (Fig. 1; column 1, lines 8-12) wherein programming is received interspersed with non-program material (column 4, lines 13-32 and column 5, lines 30-52) and wherein the program is recorded and played back without the non-program material (column 4, lines 13-32 and column 5, lines 32-52) based upon user payment for the removal of the non-program content (column 5, line 65-column 6, line 18 and column 6, lines 26-40) for the typical benefit of allowing the removal of unwanted program signals (column 3, lines 49-64) while still providing broadcasters with additional revenue (column 3, lines 64-68)

and allowing advertisers to more accurately assess what audience is actually viewing their advertisements (column 3, line 68-column 4, line 10).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler's system to include a second segment of ancillary information relevant to the segment of programming, wherein the first and second segments of ancillary information are selected from the plurality of segments of ancillary information in accordance with a selection algorithm, and wherein the selection algorithm is based a count of a number of presentations of the segment of programming, as taught by Zigmond, for the typical benefit of removing obsolete information and ensuring that a user is always provided with current advertising that they will have an interest in.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Butler and Zigmond's system to include presenting the second presentation having no window overlaying the segment of programming, as taught by Vogel, for the typical benefit of allowing the removal of unwanted program signals while still providing broadcasters with additional revenue and allowing advertisers to more accurately assess what audience is actually viewing their advertisements.

### ***Response to Arguments***

6. Applicant's arguments filed 08/15/05 have been fully considered but they are not persuasive.

a. On page 13, applicant argues that the statement "Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position" should be adequate to avoid any admission of fact in regards to the previously taken Official Notices.

In response, it is noted that the MPEP clearly states that "The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to **every** ground of objection and rejection in the prior Office action."

See MPEP 714.02

The blanket statement that "Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position" does not constitute a proper reply to every ground of rejection and is thus not considered a proper traversal of the Official Notices taken.

Further, it is noted that the MPEP clearly states that To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art... If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate."

See MPEP 2144.03

In this case, applicant did not *specifically* point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. The blanket statement that "Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position" does not point out any specific error or reason as to why the fact was not common knowledge or well-known in the art, and thus does not constitute a proper traversal.

b. In response to applicant's argument concerning the Official Notice taken towards the use of a set top box and the benefits therein, applicant is directed to the supplied references of Ali-Santosa (6,583,788) (column 3, lines 1-4) and Denninghoff (6,754,855) (column 1, lines 11-33).disclosing wherein set top boxes cost much less then computers (column 1, lines 11-33) which all clearly disclose that it was known that set top box equipment is cheaper and smaller then a typical computer.

Further, applicant is directed to the page 1, lines 17-23 of applicant's own background which clearly recites that the latest generation of set top boxes *incorporate powerful computers and are of low cost.*



c. On page 15, applicant argues that Butler overlays programming with hyperlinks which can be accessed to acquire ancillary, and not with ancillary information as recited in the claims.

In response, as indicated in the rejections, Butler overlays his television programming with hyperlink which indicate that additional information is available to be accessed. The hyperlinks themselves are thus the “ancillary” information, as they are clearly supplemental information overlaid onto the television program segments, and thus meet the broad claim limitations of ancillary information.

d. On page 15, applicant argues that the type of advertisement utilized by Zigmond is not in an “overlay format”.

In response, as indicated in the rejections, Butler was relied upon to disclose overlaying ancillary information onto a television segment. Butler further disclosed wherein the overlaid information was related to advertisements (see Butler at paragraph 4 and 46). Zigmond was simply relied upon to disclose the feature of replacing a first ad with a second ad to ensure that the advertisement is not out of date (see Zigmond at column 14, lines 1-12).

e. In response to applicant's argument concerning the combination of Zigmond with Butler, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any

one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In response, as indicated in the rejections, Butler was relied upon to disclose overlaying ancillary information onto a television segment. Butler further disclosed wherein the overlaid information was related to advertisements (see Butler at paragraph 4 and 46). Zigmond was simply relied upon to disclose the feature of replacing a first ad with a second ad to ensure that the advertisement is not out of date (see Zigmond at column 14, lines 1-12). The benefits of removing obsolete information, as taught by Zigmond, are unrelated to the particular advertisement type.

f. On page 17, applicant argues that “a mere statement of benefits of a proposed combination cannot, by itself, substitute for a teaching, suggestion or other motivation in the art for making a proposed combination.”

In response, it is noted that the proposed benefit “removing obsolete information” is in fact explicitly stated by Zigmond (column 14, lines 4-9). The examiner finds that achieving this benefit clearly disclosed by Zigmond is, in fact, a motivation to combine the references, so as to achieve the explicitly disclosed benefit.

g. On page 17, applicant argues that wherein “the selection algorithm is based upon a count of a number of presentations of the segment of programming”, as taught by Zigmond, does not fulfill the cited benefit.

In response, Zigmond specifically discloses wherein advertisements are replaced in a program segment (to remove obsolete information; see Zigmond at column 14, lines 1-9 as cited in the rejections above) and wherein advertisements no longer shown after a certain number of presentations (to prevent viewers from becoming frustrated with excessive exposure to an ad; see Zigmond at column 13, lines 40-47 as cited in the rejections above). These features and their explicitly disclosed benefits clearly fulfill the benefits indicated by the examiner.

h. Applicant’s unsupported statement towards the existence of “studies” directed to effective advertising techniques has been considered and is not persuasive.

i. On page 17, applicant argues that Zigmond advertisements are not necessarily “relevant” to a segment of programming.

i. As indicated in the rejections above, Butler was relied upon to disclose wherein the ancillary information is “relevant” to the segment of programming. Zigmond was merely relied upon to teach “updating” the displayed ancillary information.

- ii. Zigmond specifically discloses wherein advertisements are specifically chosen based upon the particular program being displayed (column 13, lines 48-51). This clearly meets the broad term of "relevant".

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Matthews, III (5,874,985) directed towards a content provider defining different sizes, shapes and positions for overlay messages (Figs. 4A-B; column 6, lines 12-21).

Staiger (US 2003/0177162) disclosing the use of random selection (paragraph 39 and 41).

Davison (US 2003/0026273) disclosing the use of random selection (paragraph 54).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (571) 272-7357. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Sheleheda  
Patent Examiner  
Art Unit 2617

JS



VIVEK SRIVASTAVA  
PRIMARY EXAMINER